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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,874	06/11/2002	Yasuo Tano	112372	4957

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Oliff & Berridge
P O Box 19928
Alexandria, VA 22320

EXAMINER

WEBB, SARAH K

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,874

Applicant(s)

TANO, YASUO

Examiner

Sarah K. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-16 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/4/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/05 has been entered.

Election/Restrictions

2. The restriction requirement to withdraw claims 9-16 and 18 based on election by original presentation has been withdrawn. Claims 9-16 and 18 are examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,3,4,6-9, 12-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,171,254 (Sher '254) in view of US Patent No. 6,092,898 (de Juan, Jr.)

Sher discloses a device that includes eyelid opener portions (22) and a holding portion (61). Engaging portions (66) on the holder (61) connect with connection

portions (24) on the eyelid openers and include holes (24) that are shown in Figure 2. The eyelid openers are biased apart by a spring (34). The holding portion and eyelid openers are connected in an adjustable manner, as they are removable from one another. Sher clearly states that the position of the ring (61) can be adjusted relative to the eyelid openers (column 3, lines 8-12). This also means that the ring is adjustable relative to the eyeball. Sher states that it's obvious to use various forms of connection means, such as hook and loop structure, between the holding portion (61) and eyelid openers (22) (column 3, lines 13-26).

Sher fails to state that the holding ring is connected to a surgical lens, although the structure is capable of performing this function. De Juan discloses a method of viewing the interior of an eye and teaches that it is known in the art to place a surgical lens (20) on the surface of the eye (column 1). De Juan teaches that the surgical lens can be held on or near the eye by a ring (10) or viewing device (30) (column 3, line 22-25 and column 7, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Sher device to hold a surgical lens, as de Juan teaches that various types of devices with a ring shaped portion can be used to position the lens relative to the eye during a surgical procedure so that the surgeon can view the interior of the eye. Since the Sher device would allow the lens to be releasably placed on the eye, the surgeon would not be required to hold a tool for this purpose.

Regarding claims 6 and 7: Sher fails to disclose expressly forming the adjustable connection portions between the ring (61) and the eyelid openers (22) to include a closed loop of elastic silicone rubber. Sher teaches that any type of alternative equivalent mechanical attachment mechanism could be used to secure the

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ring (61) to the eyelid openers (column 7, lines 13-27). Sher even states that a hook and loop, or Velcro, mechanism could be used. At the time the invention was made, it would be an obvious matter of design choice to replace the connection bars (68,66) on the ring of Sher with a simple loop of rubber, because Applicant has not disclosed that the rubber loop connection mechanism solves any particular problem or has an advantage over other attachment mechanisms known in the art. Therefore, it would be obvious to simply tie the ring to the eyelid openers with a loop of silicone rubber. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the attachment mechanisms disclosed by Sher '254, because the attachment mechanisms of Sher are adjustable.

4. Claims 1,4,5,9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,556,417 (Sher) in view of US Patent No. 6,092,898 (de Juan, Jr.)

Sher discloses a device that includes eyelid opener portions (22) and a holding portion (61). Connecting portions (44,42,40) attach the ring (61) to the eyelid openers and an elastic member (36) is included in this connection means. Figures 2, and 2A show more clearly that the ring (61) is chamfered. Sher explains that the position between the ring (61) and eyelid openers (22) is adjustable (lines 30-37). This also means that the position of the ring relative to the eyeball is adjustable. Sher does include an adjustable mechanism in the form of a collar and set screw (26,32) for connecting the eyelid openers.

Sher fails to state that the holding ring is connected to a surgical lens, although the structure is capable of performing this function. De Juan discloses a method of

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viewing the interior of an eye and teaches that it is known in the art to place a surgical lens (20) on the surface of the eye (column 1). De Juan teaches that the surgical lens can be held on or near the eye by a ring (10) or viewing device (30) (column 3, line 22-25 and column 7, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the Sher device to hold a surgical lens, as de Juan teaches that various types of devices with a ring shaped portion can be used to position the lens relative to the eye during a surgical procedure so that the surgeon can view the interior of the eye. Since the Sher device would allow the lens to be releasably placed on the eye, the surgeon would not be required to hold a tool for this purpose.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sher '254 in view of de Juan, Jr., and further in view of US Patent No. 3,139,298 to Grabiell.

Sher fails to form the holding portion for the lens from a frosted material. Grabiell teaches that an apparatus for use near the eye should include a frosted surface so that reflection is prevented (column 3, lines 65-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a frosted surface on the Sher '254 device, as taught by Grabiell, so that light is not reflected from the surface of the device during the procedure.

Response to Arguments

6. Applicant's arguments filed 11/17/05 have been fully considered but they are not persuasive. Applicant argues that the connecting portion of Sher is not adjustable while it is connected to the holding portion and eyelid opener portion. This is not

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necessarily required by the claims. Claim 1 states "the connecting portion connected to the holding portion and the eyelid opener portion so that a position of the holding portion relative to the eyelid opener portion and the eyeball is adjustable." This language does not exclude the adjustable structures of Sher, which may be disconnected while adjusting their position. Applicant's arguments are only directed toward the vacuum and hole mechanism, but Sher teaches that other mechanical connecting mechanisms, such as hook and loop connection means, could be used. Sher specifically states that the connecting portion should be adjustable. Therefore, the arguments are not found to be persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K. Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW
2/28/06



JULIAN W. WOO
PRIMARY EXAMINER